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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

YOUNG, MICAH PAUL

ART UNIT PAPER NUMBER

1615

DATE MAILED: 04/06/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/060,060	Applicant(s) ROLF ET AL.	
	Examiner Micah-Paul Young	Art Unit 1615	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 December 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 121-196 is/are pending in the application.
- 4a) Of the above claim(s) 129, 137 and 195 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 121-128, 130-136, 138-194 and 196 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Acknowledgment of Papers Received: Amendment/Response filed 12/23/03.

Applicant has canceled claims 1-120 and submitted new claims 121-196. Claims 121 – 196 are now pending. Pursuant with the species election made in the previous claim set, claims 129, 137, and 195 are removed from consideration as being drawn to non-elected species.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

3. Claims 121-128, 130-150, 153-160, 163-168, 170-173, 177, 180, 182-188, 192-194, and 196 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combined disclosures, teachings and suggestions of Gueret (USPN 6,225,521 hereafter '521) and Porter et al (USPN 5,785,978 hereafter '978). The claims are drawn to a method of improving the appearance of

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wrinkles in a human by applying a cosmetic patch comprising a cosmetic agent, solvent, permeation enhancer, an adhesive and a polymer.

4. '521 discloses a cosmetic patch comprising an adhesive matrix, cosmetic agent, and a flexible backing (abstract). The flexible backing can be permeable and made of materials such as polyester, polyethylene or polypropylene (col. 3, lin 43 – 50). The composition comprises acrylic copolymers in a solvent matrix (col. 4, lin. 12 – 18), and cosmetic agents such as anti-wrinkle agents, keratolytic agents (col. 4, lin. 27 – 37). The compositions skin conditioners, deodorants, and fresheners (Ibid.).

5. The formulation however is lacking permeation enhancers, the specific cosmetic agents, solvents and other components, which are well known in the art. '978 discloses a cosmetic patch comprising acrylic adhesive polymers (col. 4, lin. 59 – col. 5, lin. 8), surfactants such as sodium lauryl sulfate (col. 5, lin. 31), solvents such as pvp (col. 5, lin. 28), emollients such as gelatin and polyethylene glycol (col. 5, lin. 24 – 27). The patch comprises free-radical scavengers like vitamins A, C and E with are useful in treating wrinkles in the face and hands (col. 2, lin. 42 – col. 3, lin. 31, figures). A skilled artisan would be motivated to use the cosmetic composition of '978 with the patch of '521 in order to treat wrinkles since the composition comprises cosmetics suggested by '521 that would be useful in treating wrinkles.

Regarding claims 131-133, 138-140, 145-147, 155-157, 169, 172, 182, 188, and 194 it is the position of the examiner that such limitations do not impart patentability on the instant claims barring a showing of unexpected results establishing the criticality of the particular concentrations. Applicant is reminded that where the general conditions of a claim are disclosed

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in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation. *See In re Aller*, 220 F.2d 454 105 USPQ 233, 235 (CCPA 1955).

Furthermore the claims differ from the reference by reciting various concentrations of the active ingredient(s). However, the preparation of various cosmetic compositions having various amounts of the active is within the level of skill of one having ordinary skill in the art at the time of the invention. It has also been held that the mere selection of proportions and ranges is not patentable absent a showing of criticality. *See In re Russell*, 439 F.2d 1228 169 USPQ 426 (CCPA 1971).

6. With these things in mind one of ordinary skilled in the art would be motivated to combine the teachings and suggestions of the art. A skilled artisan would have followed the suggestions of '521 to include anti-wrinkle and other cosmetic agents, and combine the composition of '978 with the device of '521. An artisan would have been motivated since '978 discloses an anti-wrinkle composition and the combination would produce a flexible patch useful in wrinkle treatments, with less skin irritation, thanks to the substrate of '521. It would have been obvious to combine these teachings and suggestions, with an expected result of a method of treating wrinkles comprising applying a patch of the combination.

7. Claims 151, 152, 161,162, 174-176, 178,179, and 189-191 and rejected under 35 U.S.C. 103(a) as being unpatentable over the combined disclosures of Gueret (USPN 6,225,521 hereafter '521), Porter et al (USPN 5,785,978 hereafter '978), Cilento et al (USPN 5,059,189 hereafter '189), Smith et al (USPN 5,460,620 hereafter '620), Crotty et al (USPN 6,106,857 hereafter '857), Mitra et al (USPN 5,890,486 hereafter '486), and Torgerson et al (USPN 5,730,966 hereafter '966). The claims are drawn to a method of improving the appearance of

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wrinkles in a human by applying a cosmetic patch comprising a cosmetic agent, solvent, permeation enhancer, an adhesive and a polymer.

8. As discussed above the combination of '521 and '978 creates a device, which obviates the instant claims. However the combination is lacking the particular emulsifier, keratolytic agent, fragrances, fillers and astringents of the instant claims.

9. '189 et al discloses an adhesive patch comprising a pressure sensitive adhesive matrix, a flexible backing, and antioxidants as active agents. The device also comprises pectin in the matrix and polyester fibers in the backing material (col. 3, lin. 54 – co. 7, lin. 26). A skilled artisan would have been motivated to include the pectin to improve the consistency of the formulation.

10. '620 discloses a transdermal device which to the skin dermatological agents (Abstract). The device comprises a flexible backing, and the matrix comprises resorcinol as a keratolytic agent (examples). A skilled artisan would have been motivated to include the keratolytic agent of '620 into the combination in order to improve the health of the applied skin.

11. '620 also suggests the inclusion of fragrances into the device. '620 suggests the inclusion as an optional addition along with lotions, ointments and other helpful components. '620 however does not disclose a particular fragrance, though choosing one would be well within the level of ordinary skill in the art. This is seen in '857 et al. '857 et al discloses a pressure sensitive adhesive patch used to remove keratoic plugs, which comprises fragrances such as musk and vanilla (col. 2, lin. 55 – col. 4, lin. 46). It would have been obvious to a skilled artisan to include a fragrance into the composition in order to provide a pleasant masking effect for the cosmetic agents.

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12. '620 also suggest the inclusion of inert fillers such as dextrin, yet does not disclose malto dextrin or a concentration for such fillers. '486 discloses fillers such as malto-dextrin used in transdermal deliver patches with adhesive matrices (col. 9, lin. 34 – col. 10, lin. 11). The reference lacks the concentrations as recited in the instant claims, but as previously discussed these concentrations can be determined through routine experimentation, which is within the level of ordinary skill in the art.

13. '966 discloses a transdermal preparation for cosmetic use, specifically the treatment of hair and skin, comprising a polymeric matrix. The polymeric matrix further comprises the astringent witch hazel (col. 23, lin. 24 – col. 24, lin. 40; examples). A skilled artisan would have been motivated to include the astringent of Torgerson in order to minimize the pores of the skin.

14. With these things in mind a skilled artisan would have been motivated to combine the emulsifiers of '189 in order to improve the consistency of the formulation; the keratolytic compound of '620 in order to dissolve any keratotic material in the skin such as black-heads; fragrance of '857 in order to mask any harsh odors of the cosmetic components and add freshness; the fillers of '486 in order improve the cohesiveness of the formulation; and the astringents of '966 in order to reduce the appearance of pores in the treated skin. It would have been obvious to a skilled artisan to combine these teachings as such with an expected result of a cosmetic patch capable of treating the appearance of wrinkles and a method of applying.

Response to Arguments

15. Applicant's arguments with respect to claims 1-120 have been considered but are moot in view of the new ground(s) of rejection. However, the Examiner would like to address certain arguments regarding some of the cited art.

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16. Regarding the combination of '620 with '978, applicant argues that hindsight in employed to arrive at the combinations. In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Applicant further argues that any combination with '978 would not have a reasonable level of success, and would not be obvious to a skilled artisan. It is the position of the examiners that since each of the references cited are within the same field of endeavor, and since a skilled artisan would have full working knowledge of each component, they would know to what extent each component would affect the resultant patch and the skin. Each component combined has a long and well-known history of effective use in the cosmetic arts. It is prima facie obvious to combine two compositions each of which is taught by the prior art to be useful for the same purpose, in order to form a third composition to be used for the very same purpose. The idea of combining them flows logically from their having been individually taught in the prior art. See *In re Kerkhoven*, 626 F.2d 846, 850, 205 USPQ 1069, 1072 (CCPA 1980). For these reason the same references were applied to the new claims, which continue to obviate the prior art.

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Conclusion

17. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Correspondence

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Micah-Paul Young whose telephone number is 571-272-0608. The examiner can normally be reached on M-F 7:00-4:30 every other Monday off.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thurman K Page can be reached on 571-272-0602. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Micah-Paul Young
Examiner
Art Unit 1615

MP Young


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